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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,532	07/06/2001	Leonid Zhelnin	02973.00040	3386

22907 7590 10/20/2004

BANNER & WITCOFF  
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WASHINGTON, DC 20001

EXAMINER
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GUCKER, STEPHEN

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/899,532

Applicant(s)

ZHELNIN ET AL.

Examiner

Stephen Gucker

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 and 13-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### RESPONSE TO AMENDMENT

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
3. Claims 2, 3, 6, 8 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification teaches that "a coding sequence for the receptor is shown in SEQ ID NO:1" (page 9, lines 1-3). The specification, however, does not teach the concept of "the open reading frame contained within the nucleotide sequence shown in SEQ ID NO:1" as the amended claims now recite. This is a new matter rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3, 6, 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite because there are a total of three possible open reading frames that may be contained within the nucleotide sequence shown in SEQ ID NO:1, depending upon where the skilled artisan would start and stop translating the genetic code found within SEQ ID NO:1, because

every 3 nucleotides can encode a single amino acid. Therefore, the opening reading frame changes depending upon if the translation begins at the first, second, or third nucleotide of every possible triplet.

5. Claims 1-8 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Valenzuela et al. (WO 00/11015, "Valenzuela"). SEQ ID NOs: 25 and 26 of Valenzuela are identical to instant SEQ ID NOs: 1 and 2, respectively, of the instant invention. See pages 40-43 and 144-145 of Valenzuela.

*Applicant's arguments filed 6/25/04 are not persuasive because Applicant's affidavits and exhibits documenting the invention of SEQ ID NO:1 before the date of the reference cannot be read by the Examiner because the poor photocopies of the lab notebooks containing the sequence information is too small and too poorly reproduced to be legible. Furthermore, the arrangement and presentation of the evidence might be more persuasive if Applicant clearly indicated which exhibit provided which exact nucleotides within SEQ ID NO:1 and how the sequence in toto could be assembled from the evidence submitted so far. The easier Applicant makes it for the Examiner to follow the argument and analyze the evidence in a clear fashion in order to show the possession of SEQ ID NO:1 in its entirety (i.e. Exhibit 9 shows nucleotides 1-100 of SEQ ID NO:1 on line x, nucleotide y to line z, nucleotide zz; Exhibit 10 shows nucleotides 101-200 of SEQ ID NO:1 on line x, nucleotide y to line z, nucleotide zz; etc.), the better the chances are that the rejection can be obviated.*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1647

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (571) 272-0961. The fax phone number for this Group is currently (703) 872-9306.

*SG*

Stephen Gucker

October 18, 2004

*Michael P. Pak*  
MICHAEL PAK  
PRIMARY EXAMINER